



# UNITED STATES PATENT AND TRADEMARK OFFICE

*CM*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,389	03/12/2004	Mitsunori Ono	3211.1013-001	1892
21005	7590	09/01/2006	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			HABTE, KAHSAI	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



### DETAILED ACTION

1. Claims 1-28 are pending in this application.

### *Election/Restriction*

2. Applicant's election with traverse of Group II drawn to compounds of Formula (1) where  $V_1 = V_2 = V_3 = C$  and  $V_4 = N$  in the reply filed on 7/24/2006 is acknowledged. The traversal is on the ground that "The examiner restricted Claims 15 and 16 and classified as Group VII as being drawn to complex compositions. However, claims 15 and 16 depend from independent Claim 14. Thus, Claims 15 and 16 are patentable once one of ingredients, e.g. at least one compound according to claims 1 has also been shown to be novel and nonobvious. MPEP 806.05 (C) states....The examiner did not show any evidence that claims 15 and 16 are patentable without the details of Claim 14...there should be no additional search burden on the examiner ". The examiner disagrees with applicants. The compounds and simple composition of Group II are different from Group VII (complex composition), because of the additional ingredient present in the complex composition. Note that there is a possibility of synergistic interaction, which is usually the purpose of the complex composition in the first place. Furthermore coexamination Group VIII would require search of subclasses unnecessary for the examination of the elected claims. The examiner has to search for the additional ingredient in class 514 or in other commercial search databases. Therefore, coexamination of the additional invention would require a serious additional burden of search.

Art Unit: 1624

The requirement is still deemed proper and is therefore made FINAL.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

***Information Disclosure Statement***

4. Applicant's Information Disclosure Statement, filed on 12/8/2004 and 11/18/2004 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the term "substituted" is indefinite. In the absence of the specific moieties intended to effectuate

Art Unit: 1624

modification by the "substitution" or attachment to the chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

b. In claim 1, the phrase "Ring A substituent" is indefinite. What substituent? What is covered and what is not? Applicants have to recite Ring A substituents to overcome this rejection.

c. Regarding claim 4, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

d. In claim 13, the phrase "Compounds (I-1) through (I-14)" is indefinite. What compounds? If applicants intend compounds that are disclosed in the specification, they have to recite the compounds in the claims.


### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte  
Primary Examiner  
Art Unit 1624

KH  
August 30, 2006